



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,937	01/24/2000	Koji Nakagiri	862.C1801	6485

5514 7590 03/18/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 03/18/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/489,937

Applicant(s)

NAKAGIRI ET AL.

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment filed 1/5/2004, to the original application filed 1/24/2000, with priority filing date of 1/28/1999.
2. The objection to the title of the invention has been withdrawn as necessitated by amendment.
3. Claims 1-37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid and Ogura.
4. Claims 1-37 are pending. Claims 1, 8, 15, 22, 29, 30, 31, 36, 37 are independent claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. (hereinafter Schmid), U.S. Patent No. 5,659,164 issued August 1997, in view of Ogura (hereinafter Ogura), U.S. Patent No. 5,019,916 issued May 1991.

In regard to independent claim 1, Schmid teaches an electronic facsimile method comprising scanning a document, and electronically transmitting said document along with page specific information, said document and page information temporarily (inherently) stored in memory in an intermediate format (i.e. digital data stored in RAM memory) prior to, and during transmission of information (Schmid Abstract, column 2 lines 4-

Art Unit: 2176

23, 27-33, 40-45, 57-61, column 4 lines 57-67; compare with claim 1 “*An information processing system....said system comprising:*”, and “*temporary storing means for temporarily storing, on a storage medium in an intermediate data format, output image data composed of a plurality of pages as well as output configuring information;*”).

Schmid teaches storing page size information on a cover page of a document, said information used for ascertaining final page size (Schmid column 4 lines 57-67, Figure 4; compare with claim 1 “*acquisition means for acquiring output size of a prescribed page...by said temporary storing means;*”).

Schmid does not specifically teach changing the size of each page based upon the output size. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station's paper size. If said receiving station's paper size differs from the fax size, then the receiving station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station's paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30; compare with claim 1 “*changing means for controlling the size of each page of the output image data based upon the output size acquired by said acquisition means such that all the pages coincide in size with the output size of the prescribed page.*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura's image resizing information to Schmid's cover page size information, providing Schmid the benefit of destination page size information, in order to change page size (originally declared by Schmid's cover sheet data) to fit said data, as well as fitting a variety of paper sizes within various facsimile machine brands.

In regard to dependent claim 2, Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67).

In regard to dependent claim 3, Schmid does not specifically teach changing the size of each page based upon the output size as specified by the cover sheet data. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station's paper size. If said receiving

Art Unit: 2176

station's paper size differs from the fax size, then the receiving station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station's paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30, Figure 1, 4) It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura to Schmid, providing Schmid the benefit of destination page size information, in order to temporarily modify Schmid's cover sheet page size content information, so as to fit a variety of paper sizes within various facsimile machine brands.

In regard to dependent claim 4, Schmid does not specifically teach changing the size of each page based upon the output size as specified by the cover sheet data, so as to be identical with output paper size. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station's paper size. If said receiving station's paper size differs from the fax size, then the receiving station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station's paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30, Figure 1, 4) It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura to Schmid, providing Schmid the benefit of destination page size information, in order to temporarily modify Schmid's cover sheet page size content information, so as to fit a variety of paper sizes within various facsimile machine brands.

In regard to dependent claims 5, 6, as presented in the rejection of claim 1, above, Schmid (in view of Ogura) teaches enlarging/reducing output page sizes, based upon analysis of Schmid's cover sheet information and Ogura's applied teaching of transmitted paper size information. Since a cover sheet is typically part of a transmitted fax document, and since page size modifications apply to a faxed document, said cover sheet is also changed accordingly (see also Schmid column 4 lines 57-67) (compare with claims 5, 6).

In regard to dependent claim 7, Schmid teaches a fax transmission (Schmid column 2 lines 27-34, especially lines 40-44).

In regard to claims 8-14, claims 8-14 reflect the apparatus comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

In regard to claims 15-21, claims 15-21 reflect the computer executable methods comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

In regard to claims 22-28, claims 22-28 reflect the computer executable methods comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

In regard to independent claim 29, claim 29 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and is rejected along the same rationale.

In regard to independent claim 30, claim 30 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and is rejected along the same rationale.

In regard to independent claim 31, claim 31 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Art Unit: 2176

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 31 “*to attach cover page information*”).

In regard to dependent claim 32, claim 32 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 7, and is rejected along the same rationale (see also Schmid Figure 1, 2A – scanned and OCR’d images of page documents.

In regard to dependent claim 33, claim 33 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 2, and is rejected along the same rationale.

In regard to dependent claims 34, 35, Schmid does not specifically disclose template information associated with cover page information, as claimed. However, Schmid teaches an “MRI” comprising a set display of page information, which provides the claimed equivalent of an information template, the size of said cover page (with attached MRI) to be adjusted (scaled) as needed (Schmid Figure 1, 4), providing Schmid the benefit of a standard presentation of information for defining fax documents.

In regard to independent claim 36, claim 36 reflects the computer executable method comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 36 “*generating cover page information*”).

In regard to independent claim 37, claim 37 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 37 “*generating cover page information*”).

Response to Arguments

7. Applicant's arguments filed 1/5/2004 have been fully and carefully considered but they are not persuasive.

Applicant argues on page 16 of the amendment that Ogura is concerned with changing (via magnification or reduction) of image data, so as to fit a specific paper size at a receiving end. Applicant stresses that Ogura is not concerned with controlling page size of incoming data based on a page size set by a prescribed page of that incoming data.

The examiner respectfully notes that primary reference (Schmid) teaches analyzing a FAX cover page containing information regarding a FAX (i.e. transmission address, mode, dither, and page size – see Schmid column 4 lines 60-65, see also instant rejection of claim 1). Since Schmid teaches a “batch” of FAXs separated by cover sheets (Schmid Figure 1), with cover page information containing specific settings (Schmid column 3 lines 15-23, 27-33), then each cover page serves to supply information describing its associated set of pages (i.e. a cover sheet typically includes items such as “total number of pages, including cover”), therefore Schmid’s page size at least specifies the size of said cover page, as well as typically describing the proposed page size of the total resulting FAXed document. What Schmid appears to lack is a teaching of forced (controlled) sizing of page documents based upon the cover sheet page size (i.e. if Schmid’s cover page specifies size A3, forcing the receiving FAX printer to adhere to Size A3 for the entire FAX, even if the rest of the pages are originally of differing page sizes).

Ogura teaches enlarging or reducing a FAX page size to fit a final printed size once said FAX is transmitted. Applying Ogura to Schmid produces a system of forced adherence of all FAX pages to a standard size (i.e. A3) dictated by the cover page size information (via enlarging or reducing, accordingly). Although

Art Unit: 2176

Applicant stresses magnification at “a receiving side”, the instant claims do not appear to make a distinction between a receiving side and a transmission side, etc.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Joseph Feild, can be reached on **(703) 305-9792**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 305-3900**.

Art Unit: 2176

10. **Any response to this action should be mailed to:**


Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703-872-9306) (for formal/after-final communications intended for entry)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Fourth Floor (Receptionist).**

William L. Bashore
Patent Examiner, AU 2176
March 15, 2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER